

### REMARKS

Claims 1-3 remain in this application.

Present claim 1 recites a bandage providing a cooling effect to a user, comprising:

(i) a flexible and leak proof cold pack container having a first end and a second end; (ii) a first bandage support member integrally attached to the first end of said cold pack container; (iii) a second bandage support member integrally attached to the second end of said cold pack container; (iv) at least one chemical agent and at least one solution collectively disposed within said cold pack container, which, when mixed, undergo an endothermic reaction; (v) means for separating said agent and said solution within at least one chamber within said cold pack container of said bandage, at least one portion of said separating means being easily broken or ruptured so that said agent and said solution may be mixed; (vi) a first skin-adhesive portion located on said first bandage support member for affixing the bandage to the body of said user; (vii) a second skin-adhesive portion located on said second bandage support member for affixing the bandage to the body of said user; and (viii) a sterile portion adapted for contact with the area of the body to be covered by said bandage.

Applicant's invention, as recited by claims 1-3, as amended, provides a bandage with cooling capabilities for a user that includes bandage support members and a flexible and leak proof cold pack member integrally attached and positioned between the support members. The cold pack member includes a chemical which endothermically reacts with water, positioned adjacent to but separate from a water source inside a common package, to instantly cool the cold pack member upon activation. The cold pack member further

comprises a sterile pad member positioned on the bottom side of the bandage, which may include an antibiotic, anesthetic, antipyretic, burn medicament, or combinations thereof.

### **Claim Rejections – 35 USC § 103**

Claims 1-3 were rejected under 35 USC 103(a) as being unpatentable over Patel (USP 4,397,315) in view of Kozak (USP 3,871,376).

Patel discloses a dressing for the body of a patient comprising, an elongated pack to produce heat or cold. The pack has a front surface and a rear surface. The dressing has an absorbent medium at least substantially covering the front and rear surface of the pack.

Kozak discloses a combination absorbent dressing and flexible cooling device which includes a cooling device superimposed over a dressing composite, and an insulating material covering said cooling device and dressing composite.

Regarding claim 1, the Examiner has indicated the following: (i) Patel discloses a bandage for providing a cooling effect to a user comprising a liquid impervious cold pack container (18), first and second bandage support members (46) integrally attached to the cold pack container, and at least one chemical agent (20) and one solution (24) that undergo an endothermic reaction when mixed; (ii) the cold pack comprises means for separating the chemical and solution (22) which is easily broken or ruptured to allow mixing (column 2, lines 44-55); (iii) the bandage also contains a portion adapted for contact with the area of the body to be covered by the bandage, which is inherently sterile since it is a

dressings used for treatment of sensitive tissue; (iv) Patel does not disclose that the two bandage support members are attached to the body by adhesive, but is held in place by the use of a belt; (v) Kozak however teaches a dressing including a cooling device in which the support members (12 and 13) have an adhesive portion for affixing the bandage to the body of said user (column 4, lines 3-6); and (vi) it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the bandage disclosed by Patel having adhesive, as taught by Kozak, to allow attachment of the bandage to the user's body without the use of an extra part or belt.

Applicant respectfully traverses the Examiner's rejection of claim 1 over Patel in view of Kozak. It is submitted that the primary reference of Patel, taken alone or in view of Kozak, does not disclose or suggest each element of present claim 1. MPEP 2143.03 states that in order to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

Clearly, the suggested combination of Patel in view of Kozak does not teach or suggest a bandage that provides a cooling effect to a user, comprising: (i) a flexible and leak proof cold pack container having a first end and a second end; (ii) a first bandage

support member integrally attached to the first end of said cold pack container; and (iii) a second bandage support member integrally attached to the second end of said cold pack container, as called for by present claim 1. Because the cold pack container defined by present claim 1 **is integrally attached at its ends** to the first and second bandage support members, it is easier to use and much more reliable in operation than any device constructed in light of the combined teachings of Patel and Kozak.

The Examiner has stated that "Patel discloses a bandage for providing a cooling effect to a user comprising a liquid impervious cold pack container (18), first and second bandage support members (46) integrally attached to the cold pack container." See paragraph 4 of the Office Action. It is submitted, however, that present claim 1 requires: (i) a flexible and leak proof cold pack container having a first end and a second end; (ii) a first bandage support member integrally attached to the first end of said cold pack container; (iii) a second bandage support member integrally attached to the second end of said cold pack container. Patel is the primary reference relied upon by the Examiner. Patel discloses three drawing figures: (i) FIG. 1 is a perspective view of the dressing of the present invention; FIG. 2 is a sectional view taken substantially as indicated along the line 2--2 of FIG. 1; and FIG. 3 is a fragmentary sectional view taken substantially as indicated along the line 3--3 of FIG. 1. See Patel at column 1, lines 41-50. As shown in Fig. 3 of Patel, the first end (32a) and the second end (32b) of the cold pack container (18) are NOT integrally attached to the first bandage support member (46) and the second bandage support member (46), respectively. There is a clearly defined pocket of empty space between the ends of the cold pack container (18) and the bandage support members. Furthermore, the cold pack container (18) is surrounded by sheets (14) of

absorbent tissue papers. Therefore, applicant submits that the cold pack container (18) of Patel is not integrally attached at its ends to first and second bandage support members, respectively. Accordingly, it is submitted that Patel in view of Kozak does not disclose all claim limitations as called for by all the words of present claim 1.

Several disadvantages are inherent with the bandage disclosed by Patel in view of Kozak. Those disadvantages include, *inter alia*, the following: (i) because the cold pack container (18) is not integrally attached at its ends to the bandage support members, the cold pack will shift and move around inside the cavity of the bandage which will cause the cold pack container (18) to lose its maximum cooling efficiency when its surface area is not maximized against the user's skin; and (ii) during movement of the user's body, especially if the bandage is placed on such bodily extremities as the arms and/or legs, the cold pack of the bandage disclosed by the combined teachings of Patel and Kozak will be prone to movement and may become "bunched up" within the cavity of the bandage causing additional discomfort to the user, and resulting in an insufficient cooling effect.

It is respectfully submitted that the combined teachings of Patel in view of Kozak fail to disclose or suggest every element of present claim 1. Significantly, nowhere does Patel disclose or suggest that a cold pack be integrally attached at its ends to the bandage support members. Similarly, nowhere does Kozak disclose or suggest the presence of bandage support members that are integrally attached to its cold pack at its ends. Finally, the combined teachings of Patel and Kozak do not disclose or suggest a cold pack that is integrally attached to first and second bandage support members at both its ends, respectively. Therefore, it is respectfully submitted that present claim 1 is patentable over Patel in view of Kozak.

Further, the primary reference of Patel could not be modified so that its cold pack container (18) is integrally attached to first and second bandage support members at both its ends, because doing so would require the removal of the sheets (14) of absorbent tissue papers. MPEP 2143.01(VI) states that the proposed modification cannot change the principle of operation of a reference – “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”. Here, any modification of the primary reference of Patel by removing the sheets (14) of absorbent tissue papers which surround the cold pack container (18), would change the principle of operation of the Patel device. Namely, the Patel bandage was designed to absorb body fluids. See especially Patel col. 2, lines 55-64. If the sheets (14) of absorbent tissue papers were removed, the bandage would lose some of its ability to absorb body fluids during its application. Therefore, any proposed modification as such would further render the Patel device unsatisfactory in its purpose of providing a bandage wherein its sheets (14) absorb body fluids. See MPEP § 2143.01(V).

Regarding claim 2, the Examiner has indicated the following. The subject matter is claimed conditionally and therefore need not be present. One could spray an anesthetic or other medicament on the bandage of Patel. Claim 2 has been amended so that the subject matter is no longer being claimed conditionally. Further, because claim 2 depends from independent claim 1, it is submitted that claim 2 is patentable over the cited references for the very same reasons.

Regarding claim 3, the Examiner has indicated the following. The separating means include a frangible member (22), the chemical is provided in solid form, and the solution is water (column 2, lines 2-6). Because claim 3 depends from independent claim 1, it is submitted that claim 3 is patentable over the cited references for the very same reasons.

Accordingly, reconsideration of the rejection of claims 1-3 under 35 USC 103(a) as being unpatentable over the combination of Patel and Kozak is respectfully requested.

#### CONCLUSION

In view of the amendments to the claims and the remarks set forth above, it is respectfully submitted that the present application is in allowable condition. Reconsideration of the Non-Final Rejection and allowance of claims 1-3, as amended, are earnestly solicited.

Respectfully submitted,  
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